

c) REMARKS

The claims are 11-22 with claims 11 and 12 being independent. Claim 18 has been amended to make it depend from claim 12, as requested.

The Examiner has, inter alia, taken Official Notice that a process cartridge with the claimed semiconductor laser is well known in the art and that semiconductor lasers with the claimed oscillation wavelength are well known in the electrophotographic art for exposing electrophotographic photosensitive members. In the Advisory Action the Examiner argued that Applicants did not seasonably challenge the Official Notice in the actions of May, 2000 and December, 2000, but "waited" until the final Office Action of January 2, 2001 to challenge the Official Notice. The Examiner argued that Applicants could have challenged the Official Notice after the May, 2000 action, after the final action of January, 2001, when the CPA was filed in February, 2002 or after the suspension was filed in May, 2002. On that basis the Examiner refused to consider the merits of the challenge in the March 3, 2002 response arguing the challenge was not "seasonably traversed" under In re Chevenard, and MPEP §2144.03. This argument is respectfully traversed.

Applicants will show that they have "seasonably traversed" the Official Notice.

A brief review of the applicable authority relating to taking "Official Notice" follows. Under MPEP §2144.03, "Official Notice" is permissible only in "rare" circumstances where the facts so noticed are of notorious character and only "fill gaps" in the ground of rejection. It is not appropriate to take Official Notice of facts without citing a

reference, where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. Assertions of technical facts or esoteric technology or specific knowledge of art must always be supported by citation to some reference work known as a standard, In re Ahlert, 165 USPQ 418 (CCPA 1970).

In the Official Action of January 2, 2001 (Paper No. 9) the Examiner first took "Official Notice" that a process cartridge with (1) the claimed semiconductor lasers was well known in the art and that (2) semiconductor lasers with the claimed oscillation wavelength were well known in the electrophotographic photosensitive members. The specific language to which Official Notice was taken was first added to claim 11 in the November 16, 2000 Amendment and was present in original claim 12 and reads as follows:

--an exposure means comprising a semiconductor laser having
an oscillator wavelength of 380 to 500 nm as an exposure light source.--
(hereafter the "Notice Language")

Clearly, one cannot instantly and unquestionably demonstrate that this "Notice Language" is well-known without some citation. Under Ahlert specific knowledge of art must always be supported by citation to a reference work. Therefore, Applicants have the right to traverse the assertion of Official Notice and the Examiner must provide documentary evidence to maintain the ground of rejection, once challenged.

Applicants have previously specifically pointed out the errors in the "facts" officially noticed as well known. In fact, Applicants have shown that semiconductor lasers with the claimed oscillation wavelength were not widely known as of

1997. The only remaining issue, therefore, is whether Applicants seasonably challenged the "Official Notice" assertion.

In MPEP §2144.03, Section B, page 2100-133, last sentence, it is said that Applicants should be allowed to challenge the Official Notice assertion in the "next reply" after the Office Action in which the common knowledge statement was made. Applicants will show that the "next reply" to the Office Action where the assertion was made is the Amendment After Final Rejection filed March 3, 2002 and that they seasonably traversed the assertion.

In the first action of May 16, 2000 (Paper No. 7), claims 11 and 12 were rejected over a variety of combined references, i.e., Pai '102 in view of Borsenberger or Nakuta '218 or EP '035 or Ueda '487 in view of Pai '102 or Borsenberger. In addition to applying these references the Examiner took Official Notice that the claimed process cartridge and apparatus are well known in the art. At that time claim 11 did not contain the semiconductor laser with oscillation wavelength of 380-500 nm language. While claim 12 did contain that language, the Examiner did not specifically take Notice that the semiconductor laser with an oscillation wavelength of 380-500 nm as exposure light was well known, instead merely stating that "the claimed process cartridge and apparatus are well known in the art."

Claim 11 recited "a demountable process cartridge having a photosensitive member, and at least one of a charging means, developing means and cleaning means. Claim 12 recited, inter alia, an apparatus having a charging means, exposure means, developing means and transfer means. Therefore, Applicants' attorney

believed that the Examiner was merely taking Notice that the general structure of process cartridges and electrophotographic apparatus were well known in the art.

The next reply to the action of May 16, 2000 was the Amendment of November 16, 2000. In that action, claim 11 was amended to include the present semiconductor laser limitations in issue. It was argued that the prior art references taught away from utilizing short wavelength light of 380-500 nm as utilized in such lasers. Applicants did not question that the general configuration of a process cartridge or electrophotographic apparatus was known.

In the next action, the Final Action of January 2, 2001, the Examiner explained on page 3 that the previous "Official Notice" taken was limited to a process cartridge or an electrophotographic apparatus with the "claimed means". The Examiner stated this position was not contested. Therefore, it is clear that this "Notice" was limited to the developing means, charging means, cleaning means and transfer means or exposure means, present in the process cartridge.

The Examiner then took for the first time "Official Notice that a process cartridge with the claimed semiconductor laser is well known and that semiconductor lasers with the claimed oscillation wavelength are well known for exposing electrophotographic photosensitive members." This was the first time that specific "Official Notice" was taken that the semiconductor laser and oscillation wavelength were well known.

In order to point out errors in a ground of rejection such as "Official Notice", a reply on the merits of the rejection is filed. This is clear since MPEP §2144.04 states that if

the traverse is inadequate, in the next Office Action the well-known statement is taken to be admitted prior art. Applicants can only traverse such a rejection in a reply on the merits.

However, in reply to the final action of January 2, 2001, a Notice of Appeal was filed and thereafter, the case was refiled as a CPA and a suspension requested. None of these papers qualifies as a reply on the merits which traverses the merits of grounds of rejection advanced.

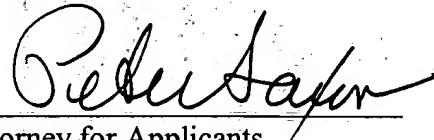
Next, the Examiner issued a first action, final rejection dated September 5, 2002 and specifically repeated that Official Notice was taken that the semiconductor laser and claimed wavelength were well-known in the art. The Examiner did not state that Applicants did not previously contest this position. The Examiner did state the Applicants did not contest the earlier position that the cartridge and apparatus are generally well-known. This clearly shows that the Examiner understood that no reply to the merits of his Official Notice directed to semiconductor laser oscillation frequency had been filed, to date.

Thereafter, Applicants timely filed a reply to the merits of the Official Notice in the response filed March 3, 2003.

Therefore, the Examiner should withdraw the holding of admitted prior art, should consider Applicants' challenge on the merits to the Official Notice of well-known art, should withdraw the Official Notice directed to semiconductor lasers and the rejection based thereon.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Peter Saper", written over a horizontal line.

Attorney for Applicants

Registration No. 24947

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

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